

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	§	Group Art Unit: 2454
Rahul L. Shah	§	
	§	Examiner: Joo, Joshua
Serial No. 10/670,550	§	
	§	Atty. Dkt. No.: 5681-69700
Filed: September 25, 2003	§	
	§	
	§	
	§	
	§	
	§	
For: METHOD AND SYSTEM FOR	§	
BUSY PRESENCE STATE	§	
DETECTION IN AN INSTANT	§	
MESSAGING SYSTEM	§	
	§	

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Anthony M. Petro

Printed Name

/Anthony M. Petro/

Signature

April 22, 2010

Date

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

This brief is in reply to the Examiner's Answer mailed February 22, 2010. Appellants respectfully request that this Reply Brief be entered pursuant to 37 C.F.R. § 41.41 and considered by the Board of Patent Appeals and Interferences.

REPLY

Each of the pending claims stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable in view of Horvitz in combination with other references. Specifically, the Examiner relies upon Horvitz as disclosing the claim features relating to “a presence state specific to said instant messenger client.”

In the Appeal Brief, Appellant argued that Horvitz does not in fact disclose the recited presence state. Appellant continues to respectfully traverse the rejection of the pending claims based on the arguments previously given. In the Examiner’s Answer, the Examiner’s responses to Appellant’s arguments regarding Horvitz each appear to center on a common point: the interpretation of “presence state” as this term appears in Appellant’s claims. Specifically, the Examiner argues that

the word “specific” in the claim does require the presence states to be generated or transitioned by internal operations of the instant messenger client. The claim does not require the presence states to be applicable only to the instant messenger client or for the presence state to be transitioned on the computer system executing the instant messenger. For instance, The American Heritage Dictionary of the English Language, 2000, (attached herewith) defines “specific” as “relating to, characterizing, or distinguishing a species” or “applying to on a particular thing”. Thus, given the broadest reasonable interpretation, Examiner considers the “presence states specific to the instant messenger client” as presence states related to or applying to modes of communication, i.e. the instant messenger.

Examiner’s Answer at 17-18.

Appellant notes that the “broadest reasonable interpretation” standard is not an unbounded standard that permits assignment of any arbitrary dictionary definition that happens to be available. Rather, “claims must be given their broadest reasonable interpretation consistent with the specification.” M.P.E.P. 2111 (emphasis added). That is, the meaning of claim terms is not determined in a vacuum. “The [PTO] determines the scope of claims in patent applications not solely on the basis of the claim language,

but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (emphasis added, internal citation omitted).

Appellant notes that the *Merriam-Webster Online Dictionary* defines “specific” as “restricted to a particular individual, situation, relation, or effect <a disease specific to horses>.” Appellant further notes that the only presence state information that is discussed in the specification is the presence state information that is reflected by the instant messenger itself. Thus, Appellant submits that the Examiner’s interpretation of a “presence state specific to an instant messenger client” as encompassing any presence state that merely relates to or applies to an instant messenger, but which need not be visible to the instant messenger itself, is not consistent with the way presence state is discussed in the specification, as the specification would be understood by one of ordinary skill. Thus, Appellant submits that the Examiner’s interpretation is unreasonable when considered in view of the appropriate legal standard.

Appellant submits that, as argued in the Appeal Brief, Horvitz discusses presence states that are not specific to an instant messenger client, but rather are generic presence states. For at least the reasons previously given, Appellant submits that Horvitz fails to disclose “presence state” as that term is recited in the claims, when properly construed in light of its usage in the specification. Accordingly, Appellant submits that Horvitz fails to support the rejection of the pending claims.

CONCLUSION

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 1-42 was erroneous, and reversal of this decision is respectfully requested.

The Commissioner is authorized to charge any fees that may be due to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-69700/AMP.

Respectfully submitted,

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